

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No.18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte E. HUGH PEMBERTON, STEPHEN M.
GIOMETTI and TIMOTHY W. SHAY

Appeal No. 2001-0672
Application 08/856,466

ON BRIEF

Before KRASS, SMITH, JERRY and LALL, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-7, all of the pending claims.

The invention is directed to a machine for inspecting glass bottles, easily understood from a review of the single drawing in the application and from independent claim 1, the claim being reproduced as follows:

1. A machine for inspecting glass bottles comprising
 - an elliptical first conveyor having parallel linear front and rear portions,
 - means for displacing bottles sequentially along the linear front portion of said elliptical first conveyor including a first cam,
 - means for displacing bottles sequentially along the linear rear portion of said elliptical first conveyor including a second cam,
 - means for inspecting bottles displaced along said front and rear linear portions including
 - at least one inspection station located proximate said front linear portion, and
 - at least one inspection station located proximate said rear linear portion,
 - a second conveyor for delivering bottles to said linear front portion of said elliptical conveyor proximate a start of said first cam, and
 - a third conveyor for receiving bottles from said linear rear portion of said elliptical conveyor proximate an end of said second cam.

No references are relied on by the examiner.

Claims 1-7 stand rejected under 35 U.S.C. §112, first paragraph, as relying on a nonenabling disclosure.

Reference is made to the brief and answer for the respective positions of

appellants and the examiner.

OPINION

The examiner's sole reason for rejecting the claims under 35 U.S.C. § 112, first paragraph, is that cam 30 and cam 32, mentioned at page 2 of the specification, are not described with sufficient structure as to enable the skilled artisan to make and use the claimed invention. The examiner agrees that there is sufficient disclosure as to the function of the cams but the examiner contends that "how" that function is accomplished, i.e., the structure of the cams, is insufficiently disclosed.

Compliance with the enablement clause of 35 U.S.C. § 112, first paragraph, requires that the written description must be sufficiently full, clear, concise and exact to enable the artisan to practice the claimed invention without resort to undue experimentation. In re Strahilevitz, 668 F.2d 1229, 212 USPQ 561 (CCPA 1982). The scope of enablement provided by the disclosure must be commensurate with the scope of protection sought by the claims. Phillips Petroleum Co. v. U.S. Steel Corp., 673 F. Supp. 1278, 6 USPQ2d 1065, 1074 (D. Del 1987), *aff'd*, 865 F.2d 1247, 9 USPQ2d 1461 (Fed. Cir. 1989).

To comply with the enablement clause of the first paragraph of 35 U.S.C. § 112, the disclosure must adequately describe the claimed invention so that the artisan could practice it without undue experimentation. In re Scarbrough, 500 F.2d 560, 182 USPQ 298 (CCPA 1974); In re Brandstadter, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973); In re Gay, 309 F.2d 769, 135 USPQ 311 (CCPA 1962). If the examiner had a reasonable basis for questioning the sufficiency of the disclosure, the burden shifted to the appellants to come forward with evidence to rebut this challenge. In re Doyle, 482 F.2d 1385, 179 USPQ 227 (CCPA 1973); In re Brown, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); In re Ghiron, 442 F.2d 985, 169 USPQ 723 (CCPA 1971). However, the burden was initially upon the examiner to establish a reasonable basis for questioning the adequacy of the disclosure. In re Strahilevitz, *supra*; In re Angstadt, 537 F.2d 498, 190 USPQ 214 (CCPA 1976); In re Armbruster, 512 F.2d 676, 185 USPQ 152 (CCPA 1975).

In the instant case, we find that the examiner did not have a reasonable basis for challenging the sufficiency of the instant disclosure and, to whatever extent the challenge was reasonable, appellants have come forward with evidence rebutting such challenge. The structure of cams 30 and 32 is not being claimed as novel or performing some hitherto unknown task. Skilled artisans in the bottle inspection art would clearly have known, from the instant disclosure, including the single figure, what

type of cam would have been suitable. Moreover, appellants identify such well known cam structure by pointing to U.S. Patent No. 4,996,658 [cam 130 (col. 4, line 54)], which is the same type of cam employed in the McNutt and Riggs references applied by the examiner in a rejection of the claims under 35 U.S.C. § 103, now withdrawn.

Thus, appellants explicitly point to an available, well-known, cam which may be used as the cam in the instant claimed invention. Yet, the examiner's response is not to argue that the well-known cams described in previous patents are unsuitable for appellants' purposes, but, rather, that reference to these patents cannot be used by appellants because "such was not evident from the original disclosure" [answer-page 5]. Clearly, when faced with a challenge regarding the enablement of a claimed invention, appellants are entitled to point to evidence, not in the original disclosure, which tends to show that a claimed element was known and available to artisans at the time of the invention. That is what appellants have done. We find appellants' reference to these documents convincing as to the notoriety of these cams to skilled artisans. The examiner's response appears to be more in the form of a response to an argued rejection under the written description clause of 35 U.S.C. § 112. That is

clearly inappropriate here since the examiner has made clear that the rejection is based on the enablement clause of that statutory section. In any event, there is no problem under the written description clause with regard to the claimed cams because there is clear support, e.g., at page 2 of the specification as pointed out by the examiner, for the claimed cams.

While the examiner argues that the “showing of cams in a different system does not mean that the claimed cams herein were enabled therefrom” [answer-page 5], appellants have said that these are the well known cams which are employed by his system and the examiner has offered no evidence to contradict that assessment that skilled artisans could use, and would have known to use, these very old and well known cams in order to practice the instant claimed bottle inspection system.

Appeal No. 2001-0672
Application No. 08/856,466

The examiner's decision rejecting claims 1-7 under 35 U.S.C. § 112, first paragraph, is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	BOARD OF PATENT
)	
JERRY SMITH)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
PARSHOTAM S. LALL)	
Administrative Patent Judge)	

EAK:yr

cc: Spencer T. Smith

Appeal No. 2001-0672
Application No. 08/856,466

EMHART GLASS MANUFACTURING, INC.
123 Day Hill Road
P.O. Box 700
Windsor, CT 06095